

## **REMARKS**

Upon entry of this Amendment, claims 1-11 and 13-19 will be pending in the application, claims 2-7 will have been amended to more accurately reflect back to claim 1, and claim 12 will have been canceled without prejudice to or disclaimer of the subject matter therein.

Claims 1-11 and 13-19 stand rejected as being allegedly unpatentable pursuant to 35 U.S.C. §§ 102 and 103.

### **35 USC 112**

Upon entry of this amendment, claim 12 will be canceled, thereby rendering this rejection moot.

### **35 USC 102**

#### **Claims 1-7**

Claim 1 stands rejected as being allegedly anticipated by Smith USP 5,661,915. Smith '915 is entitled "Shoe With Removable Spike Plate," and regards a "shoe includ[ing] a spike plate with spikes thereon, removably attached to a sole portion of the shoe to permit selective removal of the spike plate." Abstract. The undersigned submits that Smith does not disclose or suggest "an elastically deformable band defining a continuous loop," as recited in claim 1. The undersigned also submits that Smith '915 does not disclose or suggest a band with a "bottom edge ... formed in the shape of the perimeter shape of the permanent treaded bottom of the athletic footcovering," as recited in claim 1. Based on each of these distinctions, the undersigned submits that claim 1 is patentable over Smith '915.

Smith '915 includes a shoe 10 with an upper portion 12 and a sole portion 14. Smith '915 also describes a spike plate 16 for removable attachment to sole portion 14. The spike plate 16 includes vertical walls 22 and hinged base plates 20. As can be seen in Figs. 1 and 2 the front portion of the spike plate folds down and away at the

hinge. As can also be clearly seen in Fig. 2, the walls 22 are discontinuous and severed at the hinge. Thus, the hinge connects the front and rear of the spike plate together. In other words, the front and rear spike plates are two separate pieces connected by the hinge. Accordingly, Smith '915 does not disclose or suggest an elastically deformable band defining a continuous loop as in the claim. Rather, in Smith '915, two non-connected non-continuous walls 22 are shown, neither one of which defines a continuous loop as recited in the claim.

Furthermore, Smith '915 also fails to disclose or suggest a bottom edge of a band formed in the perimeter shape of the shoe. Nowhere in Smith '915 is there a band that is formed in the perimeter shape of the shoe. As to the walls 22, each half is severed or broken about the hinge and, therefore, is not formed in the perimeter shape of the footcovering as recited in the claim. Because Smith '915 fails to disclose or suggest this recited language, the undersigned submits that claim 1 is patentable over Smith '915. Furthermore, the undersigned also submits that it would not be obvious and would be improper to suggest to connect the walls 22 in Smith '915 across the hinge. Such a suggestion would change the operation of Smith '915 (which provides for a foldable bottom portion that would no longer be able to fold) and would also render Smith's hinged design useless. For at least these reasons, the undersigned submits that claim 1 and its dependent claims (nos. 2-7) are all patentable over Smith '915.

#### Clerk and Lorenzi

With regard the Office Action's citation to Clerk and Lorenzi to reject claims 5-6 the undersigned submits that Clerk and Lorenzi are irrelevant and non-analogous as they each regard typical cleated footwear and not the footwear and outersole systems to which claims 5-6 are directed. (The rigid sole plate of claims 5 and 6 is included in a sole surface which is itself coupled to a footcovering with an elastically deformable band.) Thus, the undersigned submits that the Office Action's assertion that Clerk and Lorenzi "teach[] making a rigid sole plate (3 or 4) which ... substantially corresponds to the shape of the sole of the footwear" is misplaced as the plates 3 or 4 of Clerk and

Lorenzi are part of an ordinary shoe and not a removable outersole as in the claims. Nowhere in either Clerk or Lorenzi is this recited language disclosed or suggested.

#### Claims 8-11

With regard to claims 8-11 the undersigned references the above discussion with regard to claims 1-7. The undersigned submits that Smith '915 does not disclose or suggest "an elastically deformable band secured to the entire perimeter of the removable outersole" as recited in claim 8. Additionally, the undersigned submits that it is improper to modify Smith '915 as suggested by the Office Action because such a modification would change the principle of operation of Smith '915 and would also render Smith '915 inoperable. Accordingly, the undersigned submits that claims 8-11 are patentable over the cited references.

#### Claims 2 and 11

With regard to claims 2 and 11 the undersigned submits that Smith '915 may not be modified as suggested in the Office Action because it is contrary to its teachings. Smith '915 provides that one of its objects is to "permit simple and quick removal of a spike plate from the shoe without requiring tools or the like," and to provide "convertible golf shoes which are simple to manufacture..." Col. 1, Ins. 27-31. Thus, the combination of references identified in the Office Action is improper as it seeks to add complicating components to the apparatus disclosed in Smith '915, contrary to its teachings.

#### Claims 13-19

The undersigned submits that Smith '915 fails to disclose or suggest "stretching an elastically deformable band around the perimeter of the bottom treads of the athletic footcovering, the elastically deformable band being shaped in the perimeter outline of the bottom treads of the athletic footcovering" as recited in claim 13. Moreover, drawing again from the discussion regarding claims 1-7, the undersigned submits that it would

be improper to modify Smith '915 to contain the recited language because any such modification would change the principle of operation of Smith '915 and would also render its current hinged design inoperable. Accordingly, the undersigned submits that claims 13-19 are patentable over the cited art.

### **CONCLUSION**

The Applicant requests reconsideration and allowance of each of the rejected claims in light of the above remarks and comments.

The Examiner is invited to contact the undersigned at 202-220-4311 with any questions or comments.

A paper entitled "Version With Markings To Show Changes Made" is attached hereto.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'F. Grasso', is written over a horizontal line.

Fred Grasso  
(Reg. No. 43,644)

Date: January 6, 2003

### **Version With Markings To Show Changes Made**

2. (Twice Amended) The removable cleated outsole system of claim 1 further comprising:
  - an anchoring strap having a first end and a second end,
  - the first end connected to the elastically deformable band,
  - the second end connected to the elastically deformable band,
  - the sole surface having a toe cap sized to cover the toe portion of the athletic footcovering; and
  - a rigid substantially planar sole plate coupled to and supporting the sole surface, the sole plate formed in the same shape as the sole surface.
3. (Twice Amended) The removable cleated outsole system of claim 2 wherein the anchoring strap is releasably connected to the deformable band and wherein the plurality of sport cleats are turf knobs formed as part of the bottom side of the sole surface of the removable cleated outsole.
4. (Twice Amended) The removable cleated outsole system of claim 1 wherein the elastically deformable band has a tapered cross-section, is made with spandex rubber and is the sole means for attaching the outsole to the athletic footcovering.
5. (Twice Amended) The removable cleated outsole system of claim 1 wherein the sole surface includes a rigid sole plate, the rigid sole plate sized to hav[ing]e the same perimeter shape and dimensions as the treaded bottom of the athletic footcovering.
6. (Amended) The removable cleated outsole system of claim 5 wherein the sport cleats are one of a soccer cleat, a rugby cleat, a baseball spike, a football spike, and a track sprinter's spike.

7. (Twice Amended) The removable cleated outersole system of claim 5 wherein the sport cleats are in the shape of a truncated cone with conical sides and have at least two different heights relative to one another when measured from a bottom of the sole surface.